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Sten Andersson

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EXAMINER

CHANG, EDWARD

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/506,939	<b>Applicant(s)</b> ANDERSSON ET AL.	
	<b>Examiner</b> EDWARD CHANG	<b>Art Unit</b> 3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14th of May 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### Status of Claims

1. This action is in reply to response received on 14<sup>th</sup> of May 2008.
2. Claims 1-20 are currently pending and have been examined.
3. Claims 1, 3~9, 12~14, 17, and 18 were currently amended.
4. Claim 20 was newly added.

### Response to Arguments

5. Applicant's arguments filed 14<sup>th</sup> of May 2008 have been fully considered but they are not persuasive. Referring to the previous Office action, Examiner has cited relevant portions of the references as a means to illustrate the systems as taught by the prior art. As a means of providing further clarification as to what is taught by the references used in the first Office action, Examiner has expanded the teachings for comprehensibility while maintaining the same grounds of rejection of the claims, except as noted above in the section labeled "Status of Claims." This information is intended to assist in illuminating the teachings of the references while providing evidence that establishes further support for the rejections of the claims.
6. As per claims 1, 10, and 17, applicant argues that there is no motivation to combine the applied references. In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Furthermore, the Examiner recognizes that references cannot be arbitrarily altered or modified

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and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. Although the motivation or suggestion to make modifications must be articulated, it is respectfully submitted that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

The Examiner is concerned that the Applicant apparently ignores the mandate of the numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re Delisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al* 192 USPQ 278 (CCPA) that:

- (i) obvious does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. Within *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. In *In re Conrad* 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

In the instant case, [the Examiner respectfully notes that each and every motivation to combine the applied references is accompanied by select portions of the respective references which

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specifically support that particular motivation.] As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex pane Levengood* 28 USPQ 2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

With regard to the limitations of claim 1, applicant argues that examiner didn't address the limitation "...In the central hub, initiating a deposit..." The Examiner respectfully disagrees. It is clearly shown in Column 1, Line 54, "...federal reserve bank clearing house..." used as central hub. Also regard to the limitations of claim 1, although Doggett clearly teaches all the limitations, applicant argues that claim 1 "reduces the need of cumbersome exchange of cryptographic keys, therefore it gives patentable weight. But again, examiner respectfully disagrees. Mere elimination of an element or its function does not make the claim patentable. This is clearly seen in the case law *In re Karlson* 153 USPQ 184 (CCPA 1963). Lastly regarding to the limitations of claim 1, applicant argues that combination of Doggett with Adam does not teach "initializing a verification of the second signature in the second bank and first signature in the first bank before initiating a deposit of the amount of money in the electronic payment cheque into the account of the second user. This limitation was newly added in claim 20 and also taught by Doggett on column 1, Line 59+, where it checks for the sufficient funds before transferring the funds. Please see the rejection below.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitation *...if...* is vague and indefinite because it is not clear how the claim is bounded. What happens if NOT? Please change the wording of the claim.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 1-7, 10-14, 17, 18, and 20 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Doggett et al. (hereinafter "Doggett"); (Patent# 5,677,955) in view of Adam et al. et al. (hereinafter "Adam"); (US 2002/0181710 A1).

**As per Claims 1, 10, and 17:**

Doggett as shown also discloses the following limitations:

- *processing an electronic payment cheque that relates to a transfer of an amount of money from an account of a first user in a first banking institute (500) to an account of a second user in a second banking institute (550), (See at least Column 3, Line 2+, "electronic instrument...")*
- *processing includes generating digital signatures by means of asymmetric encryption using an asymmetric key pair comprising a private key and a public key, characterized in that, the method comprises the following steps: (See at least Column 3, Line 43~65)*
- *in a first SIM card (101a) of the first user, creating an electronic payment cheque and signing the electronic payment cheque with a first signature generated by means of a first private key of a first asymmetric key pair, (See at least Column 3, Line 59+, "portable token having a memory...contains a private encryption...")*
- *which first private key is generated on the first SIM card (101a) and resides on the first SIM card (109a) hosted by a first mobile equipment (101b), (See at least Column 2, Line 60+, SIM card = "IC chip cards", mobile equipment = "computer or a terminal")*
- *via the first mobile equipment (101b) hosting the SIM card (101a) of the first user, transmitting the signed electronic payment cheque to a second SIM card (102a) hosted in a second mobile equipment (102b) of the second user, (See at least Column 8~9, Line 60+, transmission between two computing device with two signature cards)*
- *in the second SIM card (102a), signing the electronic payment cheque, which has been signed with the first signature, with an additional second signature generated on the second SIM card (102a) by means of a second private key of a second asymmetric key pair, which second private key is generated on the second SIM card 99977(102a) and resides on the second SIM card (102a) hosted by the second*

*mobile equipment (102b), (See at least Column 4, Line 6+, "the portable token may be a PCMCIA compatible card, smart card...."); (Also see at least Column 4, Line 20+, "the appended signature may be a signature of a payer....or an endorsement signature of a payee" )*

- *transmitting the electronic payment cheque signed with the first and the second digital signatures from the second mobile equipment (102b) to a central hub (300), which central hub (300) is in communication with the first and the second banking institutes (500, 550), in the central hub (300), (See at least Column 2, Line 35+, "bank's centralized computer...")*
- *Initiating a deposit of the amount of money in the electronic payment cheque into the account of the second user by initializing a verification of the second signature at the banking institution (550) of the second user and a verification of the first signature at the banking institution of the first user (500). (See at least Column 1, Line 48, "If the check looks authentic, the payee bank..."); (Also see at least Column 1, Line 56, "the payer's bank which then verifies the authenticity of the check and the signature of the payer...")*

Doggett uses a set of computers with memory cards but specifically does not disclose the using mobile phones with SIM cards to accomplish the transaction. But Adam however as shown does:

- *...first SIM card (109a) hosted by a first mobile equipment... (See at least Page 1, Paragraph 0011, "...cellular phone operating with a SIM card...")*

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the Doggett's electronic instrument as taught by Adam's transaction system using mobile phones to accomplish transactions using electronic cheque between two mobile phones. The mobility of the phones will help the users to effectively and quickly complete a transaction when and wherever it is necessary. *"The availability of cellular phones and their widespread distribution together with the realization that cellular phones are in*



*fact sophisticated communication devices led to the introduction of m-commerce (mobile commerce) - cellular phones as means for conducting payments."* (See at least Page 1, Paragraph 0004)

**As per Claims 2 and 11:**

The combination of Doggett /Adam discloses the limitations as shown in the rejections above.

Furthermore, Doggett as shown, also discloses the following limitations:

- *the transmittal of the signed electronic payment cheque from the first mobile equipment (101b) hosting the SIM card (101a) of the first user to the second SIM card (102a) hosted in a second mobile equipment (102b) of the second user, is performed via a digital mobile telephone system.* (See at least Fig. 4, Column 8~9, Line 60+, "...the electronic check, to be passed electronically to other parties to the transaction via one of the electronic networks...")

Doggett uses a set of computers with memory cards to transmit the signed electronic payment but specifically does not disclose the using mobile phones with SIM cards to accomplish the transaction. But Adam however as shown does:

- *performed via a digital mobile telephone system* (See at least Column 1, Paragraph 0001, "...a system and method of financial transactions using mobile phones...")

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the Doggett's electronic instrument as taught by Adam's transaction system using mobile phones to accomplish transactions using electronic cheque between two mobile phones. The mobility of the phones will help the users to effectively and quickly complete a transaction when and wherever it is necessary. *"The availability of cellular phones and their widespread distribution together with the realization that cellular phones are in fact sophisticated communication devices led to the introduction of m-commerce (mobile commerce) - cellular phones as means for conducting payments."* (See at least Page 1, Paragraph 0004)

**As per Claims 3, 12, and 18:**

The combination of Doggett /Adam discloses the limitations as shown in the rejections above.

Furthermore, Doggett as shown, also discloses the following limitations:

- *the signed payment cheque is transmitted as a Short Message by means of the Short Message Service system over the GSM system. (See at least Column 3, Line 19, "Digital representations of a verifiable signature of the payer may also be appended to the electronic instrument. The electronic instrument may be delivered electronically to the institution at least in part via a publicly accessible data communication medium.")*

Doggett specifically does not disclose the using of SMS in a GSM system to accomplish the transaction. But Adam however as shown does:

- *as a Short Message by means of the Short Message Service system over the GSM system. (See at least Fig. 4, Using of GSM network; also see Page 2, Paragraph 0024, "...conducted using SMS protocol")*

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the Doggett's electronic instrument as taught by Adam's transaction system using mobile phones to accomplish transactions using electronic cheque on a SMS between two mobile phones. The mobility of the phones will help the users to effectively and quickly complete a transaction when and wherever it is necessary. *"The availability of cellular phones and their widespread distribution together with the realization that cellular phones are in fact sophisticated communication devices led to the introduction of m-commerce (mobile commerce) - cellular phones as means for conducting payments."* (See at least Page 1, Paragraph 0004)

**As per Claims 4 and 13:**

The combination of Doggett /Adam discloses the limitations as shown in the rejections above.

Furthermore, Doggett as shown, also discloses the following limitations:

- *the signed payment cheque is transmitted as a Short Message by means of Ir, Bluetooth or Wi-Fi standards. (See at least Column 7, Line 23, “electronic networks such as the dial-up, Internet, wireless...”)*

**As per Claims 5 and 14:**

The combination of Doggett /Adam discloses the limitations as shown in the rejections above.

Furthermore, Doggett as shown, also discloses the following limitations:

- *payment cheque comprises indicating a telephone number associated to the second SIM card (102a), an amount to be transferred and an index to the account, wherefrom the amount should be withdrawn. (See at least Column 10, Line 5~21)*

**As per Claim 6:**

The combination of Doggett /Adam discloses the limitations as shown in the rejections above.

Furthermore, Adam as shown, also discloses the following limitations:

- *via the first mobile equipment (101b), prompting the first user to confirm creation of an electronic payment cheque, which prompting is initiated at the first SIM card (101a) hosted by the first mobile equipment (101b). (See at least Page 6, Paragraph 0124~0125, “...asked to authorize the transaction by sending an authorization message...Yet another identification form may be the generation, within the mobile phone...as presented on the phone display...”)*

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the Doggett’s electronic instrument as taught by Adam’s transaction system using mobile phones to prompt the user to confirm creation of an electronic payment cheque. This would greatly lower the risk of fraud or mistake. “*Due to the nature of the*

*transaction method of the present invention described herein this risk is eliminated (or greatly reduced)...* "(See at least Page 6, Paragraph 0124)

**As per Claim 7:**

The combination of Doggett /Adam discloses the limitations as shown in the rejections above.

Furthermore, Adam as shown, also discloses the following limitations:

- *the conformation comprises entering of a PIN-RSA number. (See at least Page 6, Paragraph 0131, "...requesting a PIN for authentication.")*

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the Doggett's electronic instrument as taught by Adam's transaction system using mobile phones to prompt the user for a PIN to confirm creation of an electronic payment cheque. This would greatly lower the risk of fraud or mistake. "*Due to the nature of the transaction method of the present invention described herein this risk is eliminated (or greatly reduced)...*" (See at least Page 6, Paragraph 0124)

**As per Claim 20:**

The combination of Doggett /Adam discloses the limitations as shown in the rejections above.

Furthermore, Doggett as shown, also discloses the following limitations:

- *if sufficient funds exist in the account of the first user in the first banking institute; then returning account information of the account to the second user as part of the verification of the second signature at the banking institution of the second user to the central hub and transmitting from the central hub to the banking institute of the first user the account information such that the banking institute of the first user may transfer the amount to the account of the second user. See at least Column 1, Line 59, "...if the check is authentic...")*

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12. Claims 8, 9, 15, 16, and 19 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Doggett/Adam and further in view of Ray et al. (hereinafter "Ray"); (US 6,067,529).

**As per Claims 8, 9, 15, 16, and 19:**

The combination of Doggett /Adam discloses the limitations as shown in the rejections above.

Furthermore, Adam discloses the following limitations:

- *the encrypted electronic payment cheque is transmitted via a message proxy in the central hub (300). (See at least Fig. 4, Column 8~9, Line 60+, "...the electronic check, to be passed electronically to other parties to the transaction via one of the electronic networks...")*
- *the encrypted electronic payment cheque at the message proxy is converted to an SMS Point to-point data download message, which subsequently is transmitted to the second SIM card hosted by the second mobile equipment. (See at least Fig. 4, Column 8~9, Line 60+, "...the electronic check, to be passed electronically to other parties to the transaction via one of the electronic networks...")*

In addition, Doggett specifically does not disclose the using of message proxy in the central hub to accomplish the transaction. But Adam however as shown does:

- *a message proxy in the central hub (300). (See at least Fig. 4, CSC = central hub; also see Page 2, Paragraph 0024, "...conducted using SMS protocol")*
- *message proxy is converted to an SMS Point to-point data download message, (See at least Fig. 4, CSC = central hub; also see Page 2, Paragraph 0024, "...conducted using SMS protocol")*

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the Doggett's electronic instrument as taught by Adam's transaction system using mobile phones to accomplish transactions using electronic cheque on a message proxy in the central hub between two mobile phones. The mobility of the phones will help the users to effectively and quickly complete a transaction when and wherever it is

necessary. *"The availability of cellular phones and their widespread distribution together with the realization that cellular phones are in fact sophisticated communication devices led to the introduction of m-commerce (mobile commerce) - cellular phones as means for conducting payments."* (See at least Page 1, Paragraph 0004, also see Fig. 4)

The combination of Doggett/Adam does not specifically state the use of *"message proxy"*. However, Ray in at least column 5, Line 8+ discloses *message proxy* in the server to properly run the *"SMS protocol."* It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Doggett/Adam with Ray because message proxy is necessary to quickly receive and convert the raw data to a text format to be efficiently used by the *"SMS protocol"*.

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
11. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Edward Chang** whose telephone number is **571.270.3092**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Kambiz Abdi** can be reached at **571.272.6702**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

Any response to this action should be mailed to:

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July 09, 2008  
/Edward Chang/ Examiner, Art Unit 3692

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